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Paper No. 6

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MAY 20 2002

OFFICE OF PETITIONS

In re Application of :
Keegan, Nagarajan, and Jana :
Application No. 09/965,142 : DECISION REFUSING STATUS
Filed: 27 September, 2001 : UNDER 37 CFR 1.47(a)
Attorney Docket No. 483471-009C1 :

This is in response to the petition filed under 37 CFR 1.47(a) on
27 February, 2002.

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor.

FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.

Extensions of time may be obtained in accordance with 37 CFR 1.136(a).

The above-identified issue application was filed on 27 September, 2001, with a declaration naming James M. Keegan, Sundaram Nagarajan, and Sushil R. Jana as joint inventors and signed by joint inventors Keegan and Nagarajan on behalf of themselves and joint inventor Jana. Accordingly, on 23 October, 2001, Initial Patent Examination Division mailed a Notice to File Missing Parts of Nonprovisional Application, requiring an oath or declaration signed by joint inventor Jana and a surcharge for its late filing.

In response, on 27 February, 2002 (certificate of mailing date 14

February, 2002), the present petition was filed, accompanied by a two (2)-month extension of time. Petitioners assert that Jana was sent a copy of the application for patent but has not returned a signed declaration.

A grantable petition under 37 CFR 1.47(a) requires:

- (1) proof that the non-signing inventor cannot be reached or located, notwithstanding diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);
- (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;
- (3) the petition fee;
- (4) a surcharge of \$130 or \$65 (small entity) if the petition and/or declaration is not filed at the time of filing the application, and
- (5) a statement of the last known address of the non-signing inventor.

The petition lacks item (2). In respect to item (2), above, it is noted that the declaration filed on 2 October, 2001, is defective in that it does not state that the person(s) making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person(s) to be material to patentability as defined in 37 CFR 1.56. Rather, the declaration incorrectly acknowledges a duty to disclose all information material to examination of the application. Additionally, the residence and mailing addresses for the non-signing inventor appear to be incorrect in that they are different from the inventor's last known address. In situations where an inventor does not execute the oath or declaration and the inventor is not deceased, such as in an application filed under 37 CFR 1.47, the inventor's most recent home address must be given to enable the Office to communicate directly with the inventor as necessary.¹ Additionally, the residence address must include the city and state where the inventor resides.² Additionally the declaration contains is defective in that it contains non initialed and/or non-dated alterations.³ Specifically, there are unsigned and/or undated changes for joint inventor Nagarajano. A new oath or declaration in compliance with 37 CFR 1.63 and 1.67, signed by

¹MPEP 605.03.

²MPEP 605.02.

³See 37 CFR 1.52(c).

all of the signing inventors on behalf of themselves and the non-signing inventor must be submitted with a renewed petition.

The power of attorney filed on 22 April, 2002, cannot be accepted because the assignee must establish its right to take action in accordance with 37 CFR 3.73. Nevertheless, correspondence is being mailed to the address specified in the declaration.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
 Box DAC
 Washington, D.C. 20231

By FAX: (703) 308-6916
 Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
 2201 S. Clark Place
 Arlington, VA

Telephone inquiries related to this decision should be directed to the undersigned at 703-308-6918.



Douglas I. Wood
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Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy